

### **REMARKS/ARGUMENTS**

In response to the Office action dated April 28, 2005 ("OA"), Applicants respectfully request the Office to enter the amendments set forth above and consider the following remarks. By this response, claims 1 and 21 are amended, and claim 19 is canceled without prejudice or disclaimer. No new matter has been added by this response. After entry of this paper, claims 1-18 and 21-22 will be pending in this application. Authorization is hereby given to charge any fees (e.g., extension fees) associated with this response to Deposit Account No. 50-1078.

In the Office action, the Examiner: (i) issued a restriction requirement, indicating restriction of prosecution between claims 1-18 and claims 21-22; (ii) rejected claims 1-18 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention; (iii) rejected claims 1-7 and 10-18 under 35 U.S.C. §102(e) as allegedly being anticipated by Austin et al., U.S. Patent 6,203,683; and (iv) rejected claims 8 and 9 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Austin et al., U.S. Patent 6,203,683.

#### **Election/Restriction**

Applicants traverse the restriction requirement, and respectfully request: (i) reconsideration of the requirement for the reasons stated below, with provisional election of claims 21-22 (1<sup>st</sup> choice) or of claims 1-18 (if election of claims 21-22 is not approved), and/or (ii) shift to prosecution of claims 21-22 (MPEP § 819.01) because such shift results in no additional work or expense, and particularly as the shift reduces work by simplifying prosecution to a reduced number of claims.

With regard to traversal, applicants respectfully submit that the Office has not provided an example of a materially different process, and thus has not met the requisite burden, and further that the "miniature analytical device" claimed in claims 1-18 is not usable in a materially different process, according to the Examiner's comments. Applicants respectfully request a specific example of such use alleged by the Office because Applicants believe that a device according to amended claim 1, for

example, is inherently and always used for some type of analysis. *Inter alia*, the temperature monitor recited in the claims implicates monitoring and hence at least analysis of temperature.

With the respect to the shift requested above, Applicants are mindful that, after an election is once made, the Office generally does not permit shift (MPEP § 819). However, especially given the reduction in Office effort mentioned above and the ability for the Office to perform a new search with the instant RCE application, Applicants respectfully request that the Examiner allow shift in this case.

Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 1-18 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite based on the "cartridge structure" recitation of claim 1. Applicants have amended claim 1 to remove reference to this term and otherwise clarify the limitations to the claimed invention contained in the first subparagraph. Accordingly, Applicants respectfully submit that the instant rejection has been overcome and should be withdrawn.

Claim Rejections - 35 U.S.C. §§ 102(e) and 103(a) over Austin

Claims 1-7 and 10-18 stand rejected under 35 U.S.C. § 102(e), and claims 8-9 stand rejected under 35 U.S.C. § 103(a), over U.S. Patent No. 6,203,683 to Austin *et al.* ("Austin"). With regard to the claims' alleged failure to define over Austin, the Examiner stated "[t]he claims to do require that each zone constrains the reactants from flowing into other zones."

Applicants have amended claim 1, as suggested by the Examiner, and respectfully submit that the instant rejections have thereby been overcome. *Inter alia*, Applicants have amended claim 1 to recite "wherein each of said temperature-controlled zones is constrained by cartridge portions that surround an area of space in which a reactant is contained and confine the reactant from flowing into other of said temperature-controlled zones." Applicants thank the Examiner for the telephone conversation wherein addition of these limitations were discussed (and, indeed, at

least preliminarily acknowledged) as overcoming the instant rejections.<sup>1</sup> Accordingly, Applicants request that the rejection of claim 1 under 35 U.S.C. § 102(e) be withdrawn and the claim allowed.

Claims 2-18 depend, directly or indirectly, from claim 1 and are allowable for at least the same reasons as claim 1. Applicants therefore request that the rejections of claims 2-7 and 10-18 under 35 U.S.C. §§ 102(e) and the rejection of claims 8-9 under 35 U.S.C. § 103(a) also be withdrawn and claims 2-18 allowed.

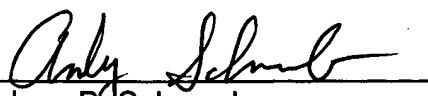
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the instant application in view of this response, and the timely allowance of the pending claims. Furthermore, the Examiner is urged to contact the undersigned by telephone, at (650) 849-6643, if an interview and/or approval of an Examiner amendment would facilitate or expedite allowance of the application.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 50-1078.

Respectfully submitted,

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Dated: July 27, 2005

By:   
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<sup>1</sup> This represents Applicants' complete written statement, in accord with 37 C.F.R. § 1.133(b), as necessary.